

epw



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/838,951

04/20/2001

Liang-Yu Chi

027-0004

1707

22120

7590

12/16/2004

ZAGORIN O'BRIEN & GRAHAM, L.L.P.
 7600B N. CAPITAL OF TEXAS HWY.
 SUITE 350
 AUSTIN, TX 78731

EXAMINER

TRINH, SONNY

ART UNIT

PAPER NUMBER

2687

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/838,951

Applicant(s)

CHI, LIANG-YU

Examiner

Sonny TRINH

Art Unit

2687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-5, 14-16 and 38-40 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6-13, 17-28 and 30-37 is/are rejected.
- 7) ☒ Claim(s) 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-2, 6-13, 17-32 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-2, 6-8, 11, 13, 18-19, 25-27, 30-32** are rejected under 35 U.S.C. 102(e)

as being anticipated by Armstrong ("Armstrong"; U.S. Patent Number 6,347,997 B1).

Regarding **claim 1**, with reference to figures 2-5, 8-9, 16 and descriptions, Armstrong teaches a method of presenting information on space constrained of a portable device (abstract, column 8 lines 12-34), the method comprising:

associating a first indication on the display with a user-defined external state;
establishing a user-defined operation for monitoring the user-defined external state; and

Art Unit: 2687

updating the first indication on the display in accordance with the monitored user-defined external state in response to an information encoding thereof received via a telecommunications network (column 8 lines 12-34).

Regarding **claim 2**, Armstrong further teaches that the user-defined external state is a stock, sports (column 8 lines 12-34).

Regarding **claim 6**, Armstrong further teaches that the step of retrieving from a networked computational service remote from the portable device, an information encoding in correspondence with a result of the performed user-defined operation (column 8 lines 12-34, e.g. stock prices and sports scores are delivered to the mobile station remotely from the network).

Regarding **claims 7-8**, Armstrong further teaches that the user-defined external state is selected from amongst a predetermined set of external states available for monitoring (column 8 lines 12-34 such as stock, sports) and inherently selected from amongst a predetermined set of at least partially-predefined queries.

Regarding **claim 11**, Armstrong further teaches that the associating of the first indication with the user defined external state and the establishing of the user-defined operation are performed via the portable device (column 8 lines 12-34).

Regarding **claim 13**, Armstrong further teaches that the first indication is a graphical indication (column 8 lines 12-34).

Regarding **claim 18**, Armstrong further teaches that the portable device is a phone (figure 9).

Art Unit: 2687

Regarding **claim 19**, Armstrong further teaches that the telecommunications network transmission and routing facilities include a wireless voice network (since the information such as stock prices and sports scores are delivered to the portable telephone, it is inherent that a wireless network is employed).

Regarding **claims 25-27**, these 3 claims combined reflect the computer program necessary for performing the steps as specified in claim 1 and is therefore rejected for the same reasons.

Regarding **claim 30**, it is inherent that the computer program product is selected from an electronic storage medium, Armstrong discloses a communication network for delivering data such as stock prices, sports to the portable telephone (column 8 lines 12-34).

Regarding **claims 31-32**, these 2 claims combined merely reflect the means necessary for performing the steps as specified in claim 1 and are therefore rejected for the same reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2687

3. **Claims 9-10, 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Armstrong ("Armstrong"; U.S. Patent Number 6,347,997 B1) in view of Harui ("Harui" U.S. Patent Number 6,690,394).

Regarding **claims 9-10**, Armstrong discloses the invention but does not disclose that the associating of the first indication with the user-defined external state is performed without use of the portable device.

In an analogous art, Harui teaches the method and apparatus for delivering WEB data to a wireless device (abstract). Harui further teaches that a user can specify the amount of information and how often to send that information to a cellular telephone (figures 3-4, see descriptions) which inherently indicates that the use of the portable device is not needed for the request of information and the establishing of the user-defined operation is performed without use of the portable device.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, within the system of Armstrong, the step of using networked computational service remote from the portable device, as taught by Harui, to eliminate the need for having a browser on the portable device to save time and memory by allowing the user to specify the information to be delivered to the wireless device at a computational device such as a computer connected to the internet.

Regarding **claim 12**, Harui further teaches that the user-defined operation includes a query executable at a networked computational service remote from the portable device (figures 1,3-4, see descriptions).

Art Unit: 2687

4. **Claims 17, 36-37** are rejected under 35 U.S.C. 103(a) as being unpatentable over Armstrong ("Armstrong"; U.S. Patent Number 6,347,997 B1).

Regarding **claim 17**, Armstrong discloses the invention but does not explicitly disclose that the display device includes a two-dimensional array of display elements suitable for simultaneously presenting plural visual indications displaced throughout at least a portion thereof. However, portable device such as telephone with plurality of displays is well known and widely used in the wireless communication field and the Examiner takes Official notice of such use in order to provide to the user additional information that one display normally cannot provide.

Regarding **claims 36-37**, Armstrong discloses the invention but does not explicitly disclose that the first indication is a graphical indication representing one of at least two states nor the graphical indication is a binary indicator. However, since Armstrong teaches that different data can be downloaded to the portable device (see column 8 lines 12-34), it is obvious and well within the level of a person of ordinary skill in the art to present the indication to the user in different states such as binary indicator, by using only binary information, the information presented can be minimized, resulting in space savings.

5. **Claims 20-24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Armstrong ("Armstrong"; U.S. Patent Number 6,347,997 B1) in view of Yamamoto ("Yamamoto" U.S. Patent Number 6,297,9454).

Regarding **claim 20**, with reference to figure 9 and description, Armstrong discloses a portable device comprising :

Art Unit: 2687

a space-constrained display with a communications interface to a telecommunications network, the communications interface coupled to the space-constrained display and allowing the portable device to receive information encoding one or more external states and to update respective ones of the visual indications based on respective user-defined associations with the external states (column 8 lines 12-34).

However, Armstrong does not disclose that the portable device including a two-dimensional array of display elements suitable for simultaneously presenting plural visual indications displaced throughout at least a portion thereof.

In an analogous art, Yamamoto teaches a portable electronic terminal apparatus having a plurality of displays (see figures 4, 7, 9, 11 and descriptions in columns 1-4).

Since both Armstrong and Yamamoto relates to portable devices with different ways of presenting information to the user via display, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, within the mobile terminal of Armstrong, the multiple displays, as taught by Yamamoto, in order to present more information to the user without having to perform complex manipulation to the display.

Regarding **claim 21**, Armstrong further discloses the external states are user selected such as sports scores (column 8 lines 12-34).

Regarding **claim 22**, Yamamoto further teaches that the plural visual indications are grouped based on correspondence of the associated external states (column 4, specifically lines 19-24).

Regarding **claim 23**, Armstrong further teaches that the telecommunications network includes a wireless data network (column 8 lines 12-34, e.g. stock prices delivered to the portable device from a cellular network).

Regarding **claim 24**, Armstrong further teaches that the portable device embodied as a phone (figure 9).

6. **Claims 28** is rejected under 35 U.S.C. 103(a) as being unpatentable over Armstrong ("Armstrong"; U.S. Patent Number 6,347,997 B1) in view of Makipaa et al. ("Makipaa" U.S. Patent Number 6,556,217 B1).

Regarding claim 28, Armstrong discloses the invention but does not disclose the information server that accesses one or more data stores in which results of monitoring of the user defined external states are encoded.

In an analogous art, Makipaa teaches a system and method for content adaptation and pagination based on terminal capabilities. Makipaa further teaches the information server for storing different information such as stock exchange, commodities market, sports etc. (figure 1, content server 20, column 4 line 39 to line 15 of column 5).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to combine the information server, as taught by Makipaa, with the system of Armstrong, in order to provide the desired information and display it according to the user selections.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. **Claims 33-35** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which (e.g. "user defined evaluation criteria") was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Allowable Subject Matter

8. **Claims 3-5, 14-16, 38-40** are allowed.

Claims 3, 14-15 have been rewritten in independent forms including the objected limitations raised by the Examiner in the previous Office action and are therefore allowable.

Claim 29 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding **claim 29**, the prior art provided numerous examples of presenting data to the user with space constrained display, but failed to disclose or fairly suggest

Art Unit: 2687

the specific combination of structural and functional limitations set forth in claim 29, specifically, wherein the first functional sequence is embodied at least in part as code implementing a web page accessible from either or both of the portable device and a networked computer.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonny TRINH whose telephone number is 703-305-1961. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester KINCAID can be reached on 703-306-3016. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SONNY TRINH
PRIMARY EXAMINER

12/9/04